

REMARKS

The present request is submitted in response to the Final Office Action dated July 27, 2004, which set a three-month period for response. Filed herewith is a Request for a Two-month Extension of Time, making this amendment due by December 27, 2004.

Claims 18-27 and 29-37 are pending in this application.

In the Final Office Action, claims 18-21, 23, 29-31, and 35-37 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,909,183 to Borgstahl et al. Claims 22, 24, 25, and 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstahl in view of U.S. Patent No. 5,917,405 to Joao. Claims 26-27 and 33-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Borgstahl et al in view of U.S. Patent No. 5,723,911 to Glehr.

The Applicant respectfully disagrees that the cited references either anticipate or make obvious the subject matter of the present invention.

With regard to independent claims 18 and 29, it is respectfully submitted that Borgstahl is not a proper reference under either **MPEP section 2131 or section 2143.03**, since the reference does not teach or suggest every element of the claim.

More specifically, the Applicant respectfully disagrees that the Borgstahl reference discloses the if-then condition that "...if the distance from the household control base drops to a predetermined limit value, or if one reaches a

predetermined region surrounding the household control base, [then] the construction of the data connection with the integrated household control system is automatically initiated via a mobile interface of the data terminal".

The Examiner states only in the final Office Action that the control of the appliance by the data terminal is affected only when the data terminal is within a predetermined distance of the appliance, referring to column 4, lines 43-45 of Borgstahl.

However, Borgstahl does not disclose that his condition is used to control the data terminal and then, if the condition is fulfilled, to automatically initiate the construction of the data connection. The Examiner has not pointed to any portion of Borgstahl as showing this feature.

Furthermore, Borgstahl does not disclose that the limit value or the region is predetermined. Rather, Borgstahl discloses that the transmit and receive section 38 monitors the wireless communication link to determine whether a signal can be received (column 6, line 67 to column 7, line 3). Therefore, the threshold is not predetermined, but random depending on the environment. In good environmental conditions, the limit value is high, whereas the value is low or even zero under bad conditions, e.g. is the peer is shielded.

Therefore, the rejection under Section 102 must be withdrawn. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984).

With regard to the rejection of claim 22, the Applicant submits that the Joao patent fails to disclose that the mobile data terminal is disposed in a motor vehicle. Instead, Joao shows the opposite of claim 22 and actually **teaches away** from claim 22, because the transmitter system 2 of Joao is located outside the vehicle. Therefore, the combination of the Borgstahl and Joao patents cannot render obvious the subject matter of claim 22.

Regarding the rejection of claims 26 and 33, neither Borgstahl nor Glehr discloses a navigation device. For example, the distance detecting device of Glehr (Fig. 4) only checks whether or not the vehicle is located in its immediate vicinity (column 3, lines 65-67), without having any navigation functionality. The same is true for Borgstahl.

Likewise, the rejection of claims 27 and 34 under the Borgstahl/Glehr combination also must be withdrawn. Neither Borgstahl nor Glehr disclose that at least one component of a mobile station of a mobile radio system serves as the position determining device. A mobile station is not mentioned in the cited references. Furthermore, neither Borgstahl nor Glehr disclose that a mobile station serves as the position determining device.

It is respectfully submitted that since the above reference combinations do not suggest the desirability of the claimed invention, such art cannot establish a **prima facie case of obviousness as clearly set forth in MPEP section 2143.01**. Please note also that the modification proposed by the Examiner with regard to the Joao reference would change the principle of operation of the prior art, so

that also for this reason the references are not sufficient to render the claims *prima facie* obvious (see the last paragraph of the aforementioned MPEP section 2143.01).

In addition, when establishing obviousness under Section 103, it is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention, if the reference does not describe or suggest its structure.

In re Mills, 16 USPQ 2d 1430, 1432-33 (Fed. Cir. 1990).

For the reasons set forth above, the Applicant respectfully submit that claims 18-27 and 29-37 are patentable over the cited art. The Applicant further requests withdrawal of the final rejections under 35 U.S.C. 102 and 103 and reconsideration of the claims as previously presented.

In light of the foregoing amendments and arguments in support of patentability, the Applicant respectfully submits that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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